



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of: JAY S. WALKER et al.

Serial No.: 09/855,300

Filing Date: May 15, 2001

For: SYSTEM FOR PROVIDING OFFERS
USING A BILLING STATEMENT

) Examiner: Not Yet Assigned

) Group Art Unit: 2165

) Attorney Docket No: 00-030

) Customer No.: 22927



Assistant Commissioner for Patents
Washington, D.C. 20231

PETITION UNDER 37 C.F.R. 1.47(a) TO REQUEST ACCEPTANCE OF NATIONAL APPLICATION WITHOUT PARTICIPATION OF ONE OR MORE INVENTORS

Sir:

Applicants request acceptance of the present application without participation of one or more inventors, which inventor(s) have either refused to join in the application or cannot be found or reached after diligent effort.

Relevant facts and proof

Applicants filed the present patent application on May 15, 2001. No Oath or Declaration was filed with the application on May 15, 2001.

Andrew Golden and John Packes, Jr., are inventors on the present application and were employed by Walker Digital until November 22, 2000, after which time they accepted other employment.

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On May 18, 2001, Applicants prepared and mailed to Andrew Golden: 1) Cover letter; 2) Assignment of Rights, Title and Interest in Invention; 3) Declaration and Power of Attorney for Patent Application; and 4) Copy of the present Application with Figures. *Please see AFFIDAVIT OF VERONIKA LELIEVER, and Exhibit A (Cover Letter Mailed May 18, 2001).*

On May 18, 2001, Applicants prepared and mailed to John Packes, Jr.: 1) Cover letter; 2) Assignment of Rights, Title and Interest in Invention; 3) Declaration and Power of Attorney for Patent Application; and 4) Copy of the present Application with Figures. *Please see AFFIDAVIT OF VERONIKA LELIEVER, and Exhibit B (Cover Letter Mailed May 18, 2001).*

Several times after mailing the copy of the present application, the Declaration and the Assignment to Andrew Golden and John Packes, Jr., Applicants attempted to confirm receipt thereof via email and by calling and leaving messages at the telephone numbers provided as contact data upon their ceasing employment with Walker Digital. *Please see AFFIDAVIT OF VERONIKA LELIEVER, AFFIDAVIT OF MICHAEL BRINTON AND AFFIDAVIT OF JAMES JORASCH.*

On October 15, 2001, Applicants again prepared and mailed to Andrew Golden, Jr.: 1) Cover letter; 2) Assignment of Rights, Title and Interest in Invention; 3) Declaration and Power of Attorney for Patent Application; and 4) Copy of the present Application with Figures. *Please see AFFIDAVIT OF VERONIKA LELIEVER, and Exhibit C (Cover Letter Mailed October 15, 2001).*

John Packes, Jr. confirmed receipt of the documents mailed to him on May 18, 2001 via telephone. Despite having twice indicated that he would stop by the office to execute the documents, and attempts by the Applicant to contact him, John Packes Jr. has not contacted the Applicants nor stopped by the office to sign the documents. *Please see AFFIDAVIT OF JAMES JORASCH and MICHAEL BRINTON.*

Andrew Golden confirmed receipt of the documents mailed to him on May 18, 2001 and October 15, 2001 via email. He indicated that they had not been executed, that he was busy and that he felt uncomfortable signing the documents. *Please see AFFIDAVIT OF VERONIKA LELIEVER and AFFIDAVIT OF MICHAEL BRINTON.*

Oath or Declaration

Applicants have filed an oath or declaration signed by all the available joint inventors with the signature block of the non-signing inventor(s) left blank.

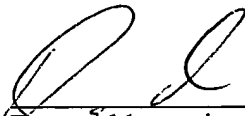
Petition Fee

Please charge \$400.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Petition, or credit any overpayment to Deposit Account No. 50-0271.

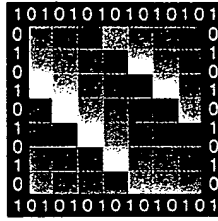
If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

November 19, 2001

Respectfully submitted,



Dean Alderucci
Attorney for Applicants
Registration No. 40,484
Walker Digital Corporation
Five High Ridge Park
Stamford, CT 06905-1325
(203) 461-7337 / voice
(203) 461-7300 / fax



WALKER
Digital

COPY

May 18, 2001

Mr. Andrew M. Golden
444 Bedford Street
Apartment 2A
Stamford, CT 06901

Re: Jay S. Walker et al. Docket No.: 00-030

**Titled: "SYSTEM FOR PROVIDING OFFERS USING A BILLING
STATEMENT"**

Dear Andrew: *Veronika*

Enclosed please find a Declaration and Power of Attorney, Assignment of Rights, Title and Interest in Invention, and Application for the above-referenced case. Kindly sign and date, in blue ink, the Declaration and Power of Attorney and the Assignment where indicated with the post-it flags. Please remember that your signature on the Assignment must be notarized. Upon execution, please return the documents in the self-addressed envelope provided for your convenience. Please note that the Application is for your reference only and is not to be included in the self-addressed envelope. Should you have a need for assistance, please call me at (203) 461-7035.

Thank you for your cooperation.

Very truly yours,

Veronika S. Leliever
Senior Patent Paralegal

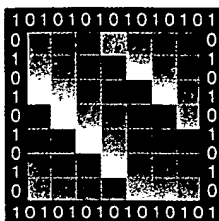
Enclosures

Hope all's well with you!

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WALKER
Digital

May 18, 2001

Mr. John M. Packes, Jr.
21 Frankford Street
Hawthorne, NY 10532-1950

COPY

Re: Jay S. Walker et al. Docket No.: 00-030

Titled: "SYSTEM FOR PROVIDING OFFERS USING A BILLING
STATEMENT"

Dear John:

J.P.

Enclosed please find a Declaration and Power of Attorney, Assignment of Rights, Title and Interest in Invention, and Application for the above-referenced case. Kindly sign and date, in blue ink, the Declaration and Power of Attorney and the Assignment where indicated with the post-it flags. Please remember that your signature on the Assignment must be notarized. Upon execution, please return the documents in the self-addressed envelope provided for your convenience. Please note that the Application is for your reference only and is not to be included in the self-addressed envelope. Should you have a need for assistance, please call me at (203) 461-7035.

Thank you for your cooperation.

Very truly yours,

Veronika

Veronika S. Leliever
Senior Patent Paralegal

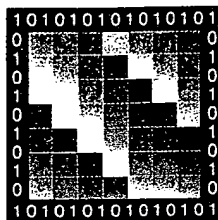
Enclosures

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*P.S. Hope all's well with you!
"V"*



COPY

October 15, 2001

Mr. Andrew P. Golden
444 Bedford Street
Apartment 2A
Stamford, CT 06901

WALKER
D i g i t a l

Re: John M. PACKES, JR. et al.

Titled: "SYSTEMS AND METHODS FOR AUTOMATED PLAY OF LOTTERY GAMES"; and

Jay S. WALKER et al.

Titled: "SYSTEM FOR PROVIDING OFFERS USING A BILLING STATEMENT"

Dear Andrew: *Andy*

In furtherance of my two letters previously mailed to you, enclosed please find another set of the following documents for each of the above referenced cases: Declaration and Power of Attorney; Assignment of Rights, Title and Interest in Invention; and an Application complete with Figures. Kindly sign and date, in blue ink, the Declaration and Power of Attorney forms and the Assignments where indicated with the post-it flags. Please remember that your signature on the Assignments must be notarized.

Upon execution, please return the documents in the self-addressed envelope provided for your convenience. Please note that the Applications are for your reference only and are not to be returned.

Also, for your convenience I have enclosed executed copies of the Walker Digital Trade Secret Protection Program and E-mail, Internet and Computer Use Policy Acknowledgement and Employee Confidentiality and Assignment of Agreement. Should you have any questions or concerns, please call me at (203) 461-7035.

Thank you for your cooperation.

Very truly yours,

Veronika
Veronika S. Leliever
Senior Patent Paralegal

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Enclosures

00-065 Patent Application with Figures; 00-065 Declaration and Power of Attorney; 00-065 Assignment of Rights, Title and Interest in Invention; 00-030 Patent Application with Figures; 00-030 Declaration and Power of Attorney; 00-030 Assignment of Rights, Title and Interest in Invention; Copy of Walker Digital Trade Secret Protection Program and E-mail, Internet and Computer Use Policy Acknowledgement; and Copy of Employee Confidentiality and Assignment Agreement.

VSL: MDB



AFFIDAVIT OF VERONIKA LELIEVER

I am employed by Walker Digital as a senior patent paralegal.

On May 18, 2001, I prepared and mailed to Andrew Golden the cover letter marked as Exhibit A, along with a copy of the present application, Combined Declaration and Power of Attorney, Assignment and self addressed stamped envelope for return to me. The cover letter included instructions to sign certain documents and return the same to me. The cover letter also included my telephone number should he require assistance.

On May 18, 2001, I prepared and had mailed to John Packes, Jr. the cover letter marked as Exhibit B, along with a copy of the present application, Combined Declaration and Power of Attorney, Assignment and self addressed stamped envelope for return to me. The cover letter included instructions to sign certain documents and return the same to me. The cover letter also included my telephone number should he require assistance.

On or before June 19, 2001, I instructed paralegal Michael Brinton to call John Packes, Jr. to confirm receipt of the documents mailed to him on May 18, 2001.

On August 6, 2001, I left a telephone message for John Packes, Jr. requesting that he contact me to confirm receipt of the documents mailed to him on May 18, 2001. I provided my telephone number in this message.

On September 17, 2001, I was forwarded an e-mail sent by Andrew Golden to Michael Brinton, in which Andrew Golden indicated that the package was not complete. In response, I sent an email to Andrew Golden inquiring as to the status of the documents mailed to him on May 18, 2001, and suggested that I could send him another package for his signature.

On October 15, 2001, further to my e-mail sent on September 17, 2001, I prepared and mailed to Andrew Golden the cover letter marked as Exhibit C, along with copies of the present application, (00-030) Combined Declaration and Power of Attorney, Assignment and self addressed stamped envelope for return to me. The cover letter included instructions to sign certain documents for this and another case as well, and return them to me. The cover letter also included my telephone number should he require assistance.

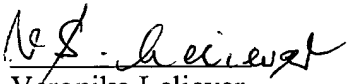
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On October 29, 2001, Andrew Golden sent me an email in response to my September 17, 2001 email to him. He confirmed receipt of the documents mailed to him on May 18, 2001 and October 15, 2001. He told me that he did not feel comfortable signing the documents, that he was busy and that he would get back to me when he could.

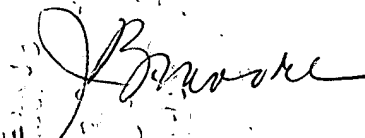
As of today, neither John Packes, Jr. nor Andrew Golden have signed any of the documents.


Veronika Leliever
November 19, 2001

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J. Brooke
NOTARY PUBLIC
MY COMMISSION EXPIRES AUG. 31, 2004



AFFIDAVIT OF MICHAEL BRINTON

I am employed by Walker Digital as a paralegal.

On June 19, 2001, upon instruction from senior patent paralegal Veronika Leliever, I attempted to contact John Packes, Jr. using a telephone number that he left as contact data after ceasing employment with Walker Digital. I left a message on his answering machine requesting that he call me to confirm receipt of the documents mailed to him on May 18, 2001. I provided my telephone number in this message.

On June 25, 2001, I attempted to contact Andrew Golden using a telephone number that he left as contact data after ceasing employment with Walker Digital. I left a message on his answering machine requesting that he call me to confirm receipt of the documents mailed to him on May 18, 2001. I provided my telephone number in this message.

On September 14, 2001, I left another telephone message for Andrew Golden requesting that he call me to confirm receipt of the documents mailed to him on May 18, 2001. I provided my telephone number in this message.

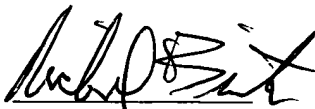
On September 17, 2001, Andrew Golden sent me an email in which he confirmed receipt of the documents mailed to him on May 18, 2001. He indicated that because the documents were incomplete, he had not executed them.

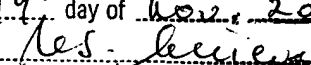
On October 4, 2001, I left another telephone message for John Packes, Jr. requesting that he call me to confirm receipt of the documents mailed to him on May 18, 2001. I provided my telephone number in this message.

On October 4, 2001, I left another telephone message for Andrew Golden inquiring as to whether he had executed the documents mailed to him on May 18, 2001. I provided my telephone number in this message.

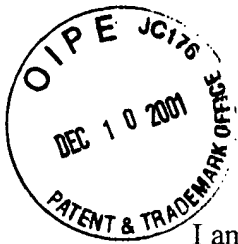
On October 15, 2001, I left another telephone message for John Packes, Jr. requesting that he call me to confirm receipt of the documents mailed to him on May 18, 2001. I provided my telephone number in this message.

As of today, neither John Packes, Jr. nor Andrew Golden have signed any of the documents.


Michael Brinton
November 19, 2001

Subscribed and sworn to before me
this 19th day of Nov. 2001

Notary Public
My Commission Expires Aug. 31, 2002

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AFFIDAVIT OF JAMES JORASCH

I am employed by Walker Digital as the Vice President of Research & Development.

On September 14, 2001, I sent an email to John Packes, Jr. requesting that he come into the office to sign documents mailed to his home on May 18, 2001. He confirmed that he had received the documents and indicated that he would be able to stop by the office to sign them.

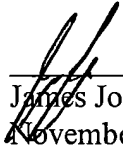
On October 3, 2001, I sent an email to John Packes, Jr. requesting that he sign the documents mailed to his home on May 18, 2001.

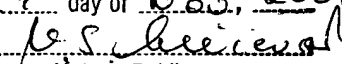
On or before October 13, 2001, I called John Packes and left a message requesting that he come into the office to sign documents.

On October 13, 2001, I sent an another email to John Packes, Jr. requesting that he come into the office to sign the documents mailed to his home on May 18, 2001. I indicated that while we did not want to designate him as a hostile inventor, we would eventually have to do so if certain deadlines were not met. He confirmed that he had received the documents and indicated that he would be able to stop by the office to sign them.

On October 24, 2001, I sent another email to John Packes requesting that he come into the office to sign the documents mailed to his home on May 18, 2001 and October 15, 2001. He again indicated that he would be able to stop by the office to sign them.

As of today, John Packes has not signed any of the documents.


James Jorasch
November 19, 2001

Subscribed and sworn to before me
this 19 day of Nov, 2001

Notary Public
My Commission Expires Aug. 31, 2002

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